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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,953	08/03/2006	Achim Ansmann	C 2809 PCT/US	1353
23657	7590	12/31/2007		
COGNIS CORPORATION PATENT DEPARTMENT 300 BROOKSIDE AVENUE AMBLER, PA 19002			EXAMINER LAMM, MARINA	
			ART UNIT	PAPER NUMBER
			1617	
			MAIL DATE	DELIVERY MODE
			12/31/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/549,953

**Applicant(s)**

ANSMANN ET AL.

**Examiner**

Marina Lamm

**Art Unit**

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/20/05</u> . | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

Claims 17-37 are pending in this application filed 8/3/06, which is a 371 of PCT/EP04/02495 filed 3/11/04, which claims priority to German application 103-12-352.0 filed 03/20/03.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 32 recites the limitation "**The** cosmetic composition..." in line 1. There is insufficient antecedent basis for this limitation in the claim. The claims should read: "**A** cosmetic composition..."

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:  
  
A person shall be entitled to a patent unless –  
  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
5. Claims 17, 22-25, 31 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Culpon, Jr. (US 5,156,759).

Culpon, Jr. teaches mineral oil replacement compositions consisting of polyalphaolefin oils such as an oligomer of 1-decene, and an ester oil such as dibutyl adipate. See col. 2, lines 9-62; col. 4, lines 49-68; col. 5. The ester oil comprises 5-20% of the composition. See Claim 2. The polyalphaolefin oils have a kinematic viscosity of 4-10 cSt at 100<sup>0</sup> C. See Claim 1.

Thus, Culpon, Jr. teaches each and every limitation of Claims 17, 22-25, 31 and 33.

6. Claims 17-20, 22, 24, 26, 27, 29-33, 35, 36 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Gordon (US 4,534,963).

Gordon teaches cosmetic compositions comprising polyolefins such as dodecene-1 and fatty esters such as octyl palmitate, isopropyl palmitate, isopropyl myristate and others, in the claimed amounts and proportions. See col. 4, lines 29-47; col. 5, lines 35-49; Examples. The compositions may contain additional emollients such as triglycerides. See col. 5, lines 49-68. The compositions of Gordon do not contain mineral oil. See Examples.

Thus, Gordon teaches each and every limitation of Claims 17-20, 22, 24, 26, 27, 29-33, 35, 36 and 37.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 23 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon (US 4,534,963).

Gordon applied as above. The reference does not explicitly teach the claimed kinematic viscosity of the polyalphaolefin. However, determination of optimal or workable viscosity of the oils by routine experimentation is obvious absent showing of criticality of the claimed parameter. One having ordinary skill in the art would have been motivated to do this to obtain the desired rheological properties of the composition.

9. Claims 21 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon (US 4,534,963) in view of Biatry et al. (US 2003/0125378).

Gordon applied as above. Gordon does not teach the hydrogenated polyalphaolefin of Claim 21 or the Guerbet alcohols of Claim 28 as additional emollients. However, Biatry et al. teach using hydrogenated polyalphaolefins for the same purpose as non-hydrogenated polyalphaolefins in cosmetic compositions. See [0042]. Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to modify the compositions of Gordon such that to use hydrogenated polyalphaolefin oil instead of non-hydrogenated polyalphaolefin oil. One having ordinary skill in the art would have a reasonable expectation of obtaining the same cosmetic effect as set forth in the Gordon reference because these oils are used interchangeably for the same art-recognized purpose as suggested by Biatry et al. Selection of a known material based on its suitability for its intended use is obvious

absent a clear showing of unexpected results attributable to the applicant's specific selection. See e.g., *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). With respect to Claim 28, Biatry et al. teach using fatty alcohols such as octyldodecanol, in cosmetic compositions for their art-recognized purpose. See [0037], [0043]. Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to modify the compositions of Gordon such that to use fatty alcohols such as octyldodecanol, of Biatry et al. with a reasonable expectation of obtaining the desired emollient effect and/or consistency of the composition.

### ***Conclusion***

10. No claims are allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 7pm.

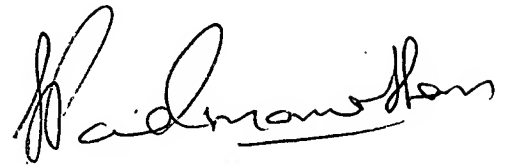
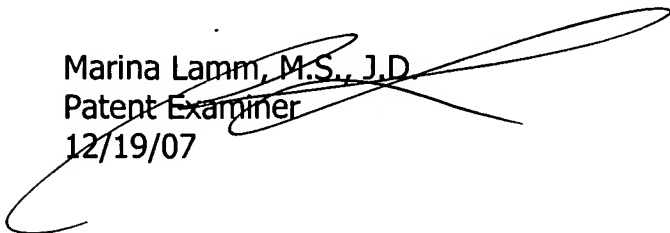
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, can be reached at (571) 272-0629.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private

Art Unit: 1617

PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marina Lamm, M.S., J.D.  
Patent Examiner  
12/19/07



12/19/07